

**REMARKS**

Claims 1- 27 are pending and subjected to restriction. Applicants herein cancel claims 1-10 and 17-22 without prejudice.

Claims 11-16 and 23-27 are rejected. Applicants have amended claims 11 and 12 to recite that there must be at least one tray, slide and reagent pack, as supported at least at p. 14, line 18, p. 16, line 11, and p. 11, lines 20-21, and to clarify the recited structures. Applicants have amended claim 16 to correct typographical errors. Applicants have amended claim 27, as discussed below. Applicants submit that no new matter is introduced by this amendments requiring further consideration or search by the Examiner.

New claim 28 is added, supported in the application as filed at least at page 15, line 16 to page 19, line 12.

Applicants respectfully request reconsideration of claims 11-16 and 23-27 for the following reasons.

**CLAIM OBJECTIONS**

Applicants have corrected the typographical error noted in claims 11 and 16.

**REJECTION UNDER 35 U.S.C. § 112**

Claim 27 is rejected under 35 U.S.C. § 112 ¶ 2 as indefinite. In response to the Examiner's request for clarity, applicants have amended claim 27 to recite that

the slide tray is for holding at least one slide and also for holding an associated reagent pack, overcoming this rejection.

#### **CLAIM REJECTION UNDER 35 U.S.C. § 102**

Claim 27 is rejected under 35 U.S.C. § 102(b) as anticipated by Tseung and Copeland.

Applicants have amended claim 27 to recite that the reagent pack is specific for a particular slide, as supported in the specification at least at p.11, lines 19-23. Neither Tseung nor Copeland disclose a reagent pack that is associated with and specific for a particular slide. In contrast, Tseung discloses a reagent container holder (Fig. 1, number 120) at a fixed location on the framework, not associated with a specific individual slide. Copeland discloses a reagent carousel with positions for a reagent container in a reagent supply zone. In Copeland's apparatus, each slide pauses in the reagent application zone, then the carousel moves the appropriate reagent container to the reagent application station (column 20, lines 16-18).

In contrast, each of applicants' slides is accompanied by an associated specific reagent pack. The reagent pack contains the reagents needed for a specific slide preparation protocol, and the information that identifies the slide preparation protocol to be performed.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

Claims 11-16 and 23-26 are rejected under 35 U.S.C. § 103(a) as obvious over Tseung in view of Kalra. Applicants respectfully disagree.

Regarding claims 11-16, Tseung does not teach, motivate, or suggest a programmable staining device that contains input features permitting the apparatus to pause during the staining run to allow new slides to be added, and then restarting the device after these slides are added, as applicants' claim 11 recites. Furthermore, the Examiner's citation to Tseung as teaching an apparatus under the control of a computer to vary the operation protocol and allowing the user to select motions from menus, and allowing the user to select slides to be treated and vary the length of treatment times, does not supply this teaching, suggestion, or motivation. This is because Tseung discloses use of the computer to vary the types of staining, not to accommodate a newly added slide within an existing program, as applicants recite.

The addition of Kalra also does not supply this teaching, suggestion, or motivation. Kalra describes an open format to allow the user to create, change, and adjust settings for individual slides and a closed format that is useful to the user to stain large batch quantities of slides.

Applicants also respectfully assert that the mere mention of "user input", as cited by the Examiner, does not provide the required clear and particular evidence in the references themselves of this teaching (*In re Dembiczak*, 50 U.S.P.Q 2d 1614 (Fed. Cir. 1999), evidence of a teaching or suggestion by the Examiner is essential to avoid hindsight, and that the Examiner can satisfy the burden of obviousness only by showing some objective teaching, which usually comes from the teachings of the pertinent reference(s)); the teachings of the pertinent reference must be clear and particular; *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000), *reh'g en banc denied, cert. denied*, 120 S. Ct. 2679 (2000) ("Although a reference need not expressly

teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular". *Winner* at 1348-49). While, with the aid of hindsight, the art may appear combinable or modifiable in a manner that will yield the claimed invention, that itself will not make the resultant modification obvious. It has long been held that the art must suggest the desirability of the modification. See *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (emphasis added). In a decision citing *In re Gordon* (*In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), the Court pointed out that "while [the prior art] apparatus may be capable of being modified to run the way [applicant's apparatus] is claimed, there must be a suggestion or motivation in the reference to do so". *In re Mills* at 1432. Finding no such suggestion in the art, the court reversed the Board.

Under these standards, applicants' respectfully disagree that it would have been obvious to one of ordinary skill in the art to include in the apparatus control formats such as pausing and restarting. Tseung in view of Kalra does not teach, suggest, or motivate an apparatus that allows the addition of new slides for staining during a staining run using pause and restart inputs.

For at least these reasons, applicants submit that independent claim 11, and dependent claims 12-16, are not obvious over Tseung in view of Kalra.

Regarding claims 23-26, applicants also respectfully assert that these are not obvious over Tseung in view of Kalra. As noted by the Examiner, neither Tseung nor Kalra teach, suggest, or motivate the incorporation of a tilttable sink assembly with

first and second drain holes on different sides. Applicants respectfully disagree that the disclosure of drain bins with exit conduits to waste reservoirs meets the standards for obviousness in relation to applicants' assembly, for the reasons previously advanced. As stated in the specification, applicants' assembly allows the user to have control over reagent removal, such as removal and handling of nonhazardous and hazardous wastes (page 10, lines 7-12).

For at least this reason, applicants respectfully submit that independent claim 23 and dependent claims 24-26 are not obvious over Tseung in view of Kalra.

Applicants also submit that new claim 28 is neither anticipated, nor rendered obvious, by any of Tseung, Copeland, and Kalra, as none of these disclose or suggest a method to add a new specimen slide to an autostainer during a staining run.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made".

## CONCLUSION

For the foregoing reasons, applicants' invention is believed to be patentable and an early Notice of Allowance is respectfully requested. No fees are believed to be due, but should any fees or surcharges be deemed necessary, the Examiner has authorization to charge fees or credit any overpayment to Deposit Account No. 23-3000.

The Examiner is invited to telephone the undersigned attorney if there are any questions or issues.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By Beverly A. Lyman

Beverly A. Lyman  
Reg. No. 41,961

2700 Carew Tower  
441 Vine Street  
Cincinnati, Ohio 45202  
(513) 241-2324 (Office)  
(513) 421-7269 (Facsimile)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 11, 12, 16 and 27 have been amended as follows:

11. (AMENDED) An apparatus for staining specimen slides, said apparatus comprising:

at least [more than] one slide tray [, said slide tray for] holding [more than]  
at least one specimen slide;

an automatic staining head assembly [, said automatic staining head assembly for depositing] operative to deposit reagents on said specimen slide[s], said automatic staining head assembly [further comprising] including an input device for reading identifiers that specify slide preparation protocols to perform;

a control system [, said control system] operatively coupled to said automatic staining head assembly for controlling said automatic staining head assembly to prepare said specimen slides during a staining run;

a pause input [, said pause input for pausing] operative to pause said apparatus during said staining run; and

a restart input [, said restart input for restarting] operative to restart said apparatus after adding new specimen slides onto [on] one of said slide trays; wherein said control system causes said automatic staining head assembly to read a new set of identifiers associated with said new specimen slides to add said new specimen slides to said staining run.

12. (AMENDED) The apparatus as claimed in claim 11 wherein said apparatus further comprises at least one reagent pack[s].

16. (AMENDED) The apparatus as claimed in claim 11 further comprising:  
a [STAT] stat restart input, said [STAT] stat restart input for restarting said apparatus after adding new specimen slides onto [on] one of said slide trays wherein said new specimen slides are given high priority[;].

27. (AMENDED) An apparatus for staining specimen slides, said apparatus comprising:

at least one slide tray, said slide tray for holding at least one specimen slide and also for holding an associated specific reagent pack, said associated reagent pack having reagents needed for processing said specimen slide; and

an automatic staining head assembly, said automatic staining head assembly for obtaining said reagents from said associated reagent pack and depositing reagents on said specimen slide.

New claim 28 has been added.